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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,581	03/16/2001	Leo J. Campbell	08049.0005	5903
22852	7590	09/29/2005		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
			EXAMINER BRUCKART, BENJAMIN R	
			ART UNIT 2155	PAPER NUMBER

DATE MAILED: 09/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/809,581

Applicant(s)

CAMPBELL ET AL.

Examiner

Benjamin R. Bruckart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-27, 50-59, 69, 70, 76 and 77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-27, 50-59, 69, 70, 76 and 77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Detailed Action

Claims 18-27, 50-59, 69, 70, 76, 77 are pending in this Office Action.

Claims 1-17, 28-49, 60-68, 71-75 and 78 are cancelled.

Claims 18, 23, 50, 55, 69, 70, 76 and 77 are amended.

There are no new claims.

The 35 U.S.C. 101, rejection is withdrawn as being erroneously asserted on cancelled claims.

Response to Arguments

Applicant's arguments filed in the amendment filed 8/18/05, are moot in view of new grounds of rejection. The reasons are set forth below.

Applicant's invention as claimed:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 18, 23, 50, 55, 69, 70, 76, 77 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18, 23, 50, 55, 69, 70, 76, 77 recites the limitation "complete physical address." This term is vague and indefinite and needs further definition. Applicant needs to define what a complete physical address is. Does an address without a zip code comprise a complete physical

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address? Does an address with only 5-digit zip code comprise a complete physical address? Does an address with a 9-digit zip complete an address or make it more complete? This term is subject to a lot of different views and interpretation and needs to be further defined to point and distinctly claim the novel features. What about complete internal address information?

Claims 18-20, 22-25, 27; 50-52, 54-57, 59; 69-70; 76-77 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,285,777 by Kanevsky et al.

Regarding claim 18, a method for delivering a message to a user with an electronic account (Kanevsky: col. 3, lines 16-24; col. 5, lines 44-52), comprising the steps of:

receiving the message directed to the user with the electronic account (Kanevsky: col. 3, lines 16-24; col. 5, lines 44-46), where the message includes an electronic address associated with the user's electronic account (Kanevsky: col. 5, lines 44-46) and a partial physical address of the user (Kanevsky: col. 5, lines 44-46; Fig. 5, tag 124; col. 2, lines 61-63);

determining a complete physical address of the user from the electronic address using an address database (Kanevsky: col. 5, lines 55-col. 6 line 4; lines 22-36); and

delivering the message to the user (Kanevsky: col. 6, lines 5-8).

Regarding claim 19, the method of claim 18, further comprising the step of: delivering the message to the user at the electronic address (Kanevsky: col. 3, lines 66 – col. 4, line 10).

Regarding claim 20, the method of claim 18, further comprising the step of: delivering the message to the user at the physical address (Kanevsky: col. 3, lines 66- col. 4, line 10).

Regarding claim 22, the method of claim 18, wherein the address database is a United States Postal Service address database (Kanevsky: col. 5, lines 49-50).

Regarding claim 23, a method for delivering a message to a user with an electronic account (Kanevsky: col. 3, lines 16-24; col. 5, lines 44-52), comprising the steps of:

receiving the message directed to the user with the electronic account (Kanevsky: col. 3, lines 16-24; col. 5, lines 44-46), where the message includes an incomplete electronic address of the user and a physical address of the user (Kanevsky: col. 5, lines 44-46; Fig. 5, tag 124; col. 2, lines 61-63);

determining a complete electronic address of the user from the physical address using an address database (Kanevsky: col. 5, lines 55-col. 6 line 4; lines 22-36); and

delivering the message to the user (Kanevsky: col. 6, lines 5-8).

Regarding claim 24, the method of claim 23, further comprising the step of: delivering the message to the user at the electronic address (Kanevsky: col. 3, lines 66 – col. 4, line 10).

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Regarding claim 25, the method of claim 23, further comprising the step of: delivering the message to the user at the physical address (Kanevsky: col. 3, lines 66 – col. 4, line 10).

Regarding claim 27, the method of claim 23, wherein the address database is a United States Postal Service address database (Kanevsky: col. 5, lines 49-50).

Claims 21, 26, 53, 58 are rejected under 35 U.S.C. 103(a) as being obvious by U.S. Patent No. 6,285,777 by Kanevsky et al in view of U.S. Patent No. 5,341,505 by Whitehouse.

Regarding claim 21,

The Kanevsky reference teaches the method for delivering a message to a user with an electronic account.

The Kanevsky reference does not explicitly state sending back information of a complete physical address.

The Whitehouse reference teaches sending back information of a complete physical address (Whitehouse: col. 6, lines 52-58).

The Whitehouse reference further teaches the invention removes the last barrier for automation providing quick, easy, and low cost lookup for complete address information (Whitehouse: col. 5, lines 57- col. 6, line 5).

Therefore it would have been obvious at the time of the invention to one of ordinary skill in the art to create the system of delivering a message as taught by Kanevsky while informing the sender of a complete address as taught by Whitehouse in order to remove the last barrier for automation providing quick, easy, and low cost lookup for complete address information (Whitehouse: col. 5, lines 57- col. 6, line 5).

Regarding claim 26, the method of claim 23, further comprising the step of: informing the sender of the complete electronic address (Whitehouse: col. 6, lines 52-58).

Claims 23-27; 50-59; 69-70; 76-77 are substantially similar directly mapping to claims 18-22 are therefor rejected along the same lines. While the examiner recognizes the differences between a method, system, and computer usable medium, the examiner equates these to the software, features of the software, and hardware embodiment in which the code runs.

18	23	50	55	69	70	76	77
19	24	51	56				
20	25	52	57				
22	27	54	59				
21	26	53	58				

REMARKS

Applicant has amended the independent claims to further clarify the physical address is partial and incomplete.

The examiner believes there are several clarity issues to be resolved with the broad language of the claim limitations. Applicant is encouraged to further define the account relationships and how the electronic mail account is used with the incomplete or partial mailing address. If an email address of an account is given, why is there a need for a partial address when the complete address could be looked up. Also the issues of the complete physical address need to be distinguished as noted above.

PRIOR ART

U.S. Patent No. 5,752,059 by Holleran et al teaches parsing email address information into fields for conversion and sending of the message.

U.S. Patent No. 6,604,132 by Hitt teaches the limitations of claim 1 (col. 3, lines 12-35 and col. 6, lines 10-36 and col. 7, lines 37-50).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin R. Bruckart whose telephone number is (571) 272-3982. The examiner can normally be reached on 8:00-5:30PM with every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Benjamin R Bruckart
Examiner
Art Unit 2155

brb



SALEH NAJJAR
PRIMARY EXAMINER